

REMARKS

Claims 1 and 100-114 are pending in the above-identified patent application. No claims are allowed.

New Claims

New claims 115 has been added. Claim 115 is an In re Beauregard<sup>1</sup> version of corresponding claim 113.

New claim 116 has also been added. Claim 116 is a means plus function version of corresponding claim 113.

The First 35 U.S.C. § 103 Rejection

Claims 1 and 100 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Irribarren<sup>2</sup> in view of Picard et al.<sup>3</sup>, among which claims 1 and 100 are independent claims. This rejection is respectfully traversed.

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<sup>1</sup> *In re Beauregard*, 53 F.3d 1853, USPQ2d 1383 (Fed. Cir. 1995).

<sup>2</sup> USP 5,737,395.

<sup>3</sup> USP 6,233,318.

According to the Manual of Patent Examining Procedure (M.P.E.P.),

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.<sup>4</sup>

Specifically, the Office Action contends that the elements of the presently claimed invention are disclosed in Irribarren, except that Irribarren teaches neither a connection notification means nor a message notification means.<sup>5</sup> The Office Action further contends that Picard et al. taught a multimedia message communication having connection notification means and a message notification means and that it would have been obvious to one of ordinary skill in the networking art at the time of the invention to have incorporated Picard et al.'s teachings of unifying message storage allowing different types of messages or electronic communications such as voicemail, facsimile, e-mail and video mail to be stored on a single system in a single unified multimedia mailbox, and accessed via different pathways, such as via a telephone network or Internet/Intranet with the teachings of Irribarren for the purpose of integrating the message system through the personal computer or Internet Communication Device either locally or remotely.<sup>6</sup> The Applicants respectfully disagree for the reasons set forth below.

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<sup>4</sup> M.P.E.P. § 2143.

<sup>5</sup> Office Action ¶ 5.

<sup>6</sup> Office Action ¶ 5.

First, the Applicants respectfully submit that there is no teaching or suggestion in the art to combine the Irribarren reference and the Picard et al. reference. Irribarren is directed to a system that allows a user to input, access and manipulate voice, facsimile and electronic mail through a personal computer.<sup>7</sup> Picard et al. is directed to an entirely different problem of accessing stored messages over a network.<sup>8</sup> Whereas the art of the present invention concerns multimedia messaging between disparate messaging platforms.<sup>9</sup> Neither Picard et al. nor Irribarren recognized the need for integrating voice, fax and email messaging between disparate messaging interfaces which employ different messaging formats and which use different networks between subscribers *and non-subscribers* through a switchable communications backbone such as the Internet<sup>10</sup>. Therefore, the Applicants submit there would be no motivation to combine the teachings of Irribarren with the teachings of Picard et al. Thus, it cannot be said that Irribarren in combination with Picard et al. make the presently claimed invention obvious. For this reason, the Applicants submit this rejection is improper and should be withdrawn.

Furthermore, the Applicants submit that Irribarren does not teach or suggest, alone or in combination with Picard et al., the presently claimed subject matter for the reasons set forth below.

#### Claim 1

Independent claim 1 recites in part:

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<sup>7</sup> Irribarren at col. 1 lines 23-27.

<sup>8</sup> Picard et al. at col. 1 lines 13-14.

<sup>9</sup> Specification at p. 1 lines 6-7.

<sup>10</sup> Specification at p. 3 lines 8-11.

An apparatus for storing and forwarding messages, the apparatus comprising:  
 a first network interface for interfacing with a network;  
 a second network interface for interfacing with an Internet network;  
 means for receiving an incoming message and delivery information from said  
 first network interface, said incoming message having a message content  
 format of a first type;

Claim 1 also recites in part:

a converter for converting said incoming message having a message content  
 format of a first type to a message having a message content format of a  
 second type in response to said incoming message and said delivery  
 information, said converter using said delivery information for selecting  
 said message content format of a second type for said message;

According to the Office Action, Irribarren teaches that a text to speech translation  
 subsystem may be used to allow the intended recipient to receive a message.<sup>11</sup> The  
 Office Action cites the following in support of this contention:

In operation, the user calls the system 100, logs in via a user number and  
 password, and is prompted to use the touchtone keypad to command the system  
 100 to accomplish specific functions. Initially the user will be told by the system  
 100 how many text messages are addressed to the previously entered user number  
 and how many of those have not been played previously. By touchtone command  
 the user may request a message or messages be played via the text to speech  
 translation system. Replies to the messages are accomplished by requesting the  
 system to send previously stored or "canned" messages to the sender's electronic  
 mail address. These pre-stored messages are typically very simple  
 acknowledgements such as "message received", "message received, I'll get back  
 to you when I return to the office", etc.<sup>12</sup>

Thus, the conversion program in Irribarren is invoked by a specific user command and is  
 applied to a message that has already been stored in the system. Irribarren does not  
 disclose or suggest a converter for converting an incoming message of a first type to a  
 message having a message format of a second type *in response to said incoming message*

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<sup>11</sup> Office Action ¶ 5.

*and said delivery information.* Moreover, Iribarren does not disclose or suggest a converter that uses the delivery information for selecting said message content format of a second type for said message.

Claim 1 also recites in part:

connection notification means for providing a recipient connection signal to the apparatus when a browser connects to said Internet network, said browser associated with a recipient of said incoming message;

According to the Office Action, Picard et al. discloses a multimedia message communication having connection notification using a standard Web browser to obtain a service provider home page where the user will log into the Internet service<sup>13</sup>. The Office Action cites the following in support of this contention:

During a typical session a user will access the platform 132 over the Internet 136 using a standard web browser to obtain a service provider home page where the user will log into the Internet service provided by the platform.<sup>14</sup>

The Picard et al. reference further discloses:

During this process the user is required to enter a mailbox identifier and a pass code which are checked to ensure that the user is authorized. Once authorization is confirmed a service session is initiated and the user is presented a page that includes a menu of service options such as viewing a message list, administering mail box options, other network service features, etc.<sup>15</sup>

Thus, Picard et al. discloses displaying a message list after a browser that already has access to the Internet is used to obtain a service provider home page, and after the user logs in to the Internet service provided by the platform. Picard et al. does not disclose or

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<sup>12</sup> Iribarren at col. 4 lines 63-67, col. 5 lines 1-10.

<sup>13</sup> Office Action ¶ 5.

<sup>14</sup> Picard et al. at col. 15 lines 61-65.

<sup>15</sup> Picard et al. at col. 15 lines 65-67, col. 16 lines 1-4.

suggest a connection notification means for providing a recipient connection signal to the apparatus when a browser *connects* to said Internet network, said browser associated with a recipient of said incoming message.

Claim 1 also recites in part:

message notification means for sending message waiting notification to said recipient via said browser if said recipient connection signal is received from said connection notification means and if at least one message has been received for delivery to said recipient.

According to the Office Action, Picard et al. discloses:

message notification means (refresh button) (Picard, col. 16, line 54-55) for sending message waiting (new message) notification.<sup>16</sup>

However, the refresh button disclosed in Picard et al. requires user interaction with a browser to initiate the refresh operation<sup>17</sup>. Furthermore, as mentioned above, the connection notification means disclosed in Picard et al. differs from the connection notification means as disclosed and claimed in claim 1. For this additional reason, it cannot be said that Irribarren in combination with Picard et al. make the presently claimed invention obvious.

In view of the foregoing, it is respectfully requested that the rejection of claim 1 be withdrawn.

#### Claim 100

Claim 100 recites:

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<sup>16</sup> Office Action ¶ 5.

A communication system having a virtual mailbox feature, comprising:  
 a first messaging apparatus having a first network interface coupled to and for transceiving messages through an Internet network, a second network interface coupled to and for transceiving messages through a first telephone network, a universal mailbox associated with a first subscriber; and  
 a second messaging apparatus having a third network interface coupled to and for transceiving messages through said Internet network, a fourth network interface coupled to and for transceiving messages through a second telephone network, a virtual mailbox associated with said first subscriber and for storing a message addressed to said first subscriber and received through said second telephone network, and a forwarding program for transmitting said message to said first messaging apparatus via said Internet network.

According to the Office Action, Iribarren in combination with Picard et al. discloses a communication system having a virtual mailbox feature.<sup>18</sup> The text cited by the Office Action speaks generally about the need for a system that allows subscriber access to stored messages that are stored in a unified multimedia mailbox through a public switched telephone network and over a data network such as the Internet.<sup>19</sup> The Office Action also makes reference to FIGS. 7-10 in Picard et al.<sup>20</sup> Figure 7 illustrates the flow of control during a refresh operation. Figures 8 and 9 depict message list and group list templates, respectively, and Figure 10 illustrates the flow of control in a retrieval operation. It is unclear how the cited references disclose a communication system having a virtual mailbox feature as disclosed and claimed in claim 100. The Applicants submit that the Examiner has failed to present a convincing line of reasoning supporting the rejection.<sup>21</sup> For this additional reason, the Applicants submit this rejection is improper and should be withdrawn.

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<sup>17</sup> Iribarren at col. 16 lines 45-46.

<sup>18</sup> Office Action ¶ 5.

<sup>19</sup> Picard et al. at col. 1 lines 55-67, col. 2 lines 34-40.

<sup>20</sup> Office Action ¶ 5.

<sup>21</sup> See *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985).

For this additional reason, it cannot be said that Irribarren in combination with Picard et al. make the presently claimed invention obvious.

In view of the foregoing, it is respectfully requested that the rejection of claim 100 be withdrawn.

The Second 35 U.S.C. § 103 Rejection

Claims 101-114 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Irribarren in view of Picard et al. and further in view of Chau et al.<sup>22</sup>, among which claims 103, 105, 111, 113 and 114 are independent claims. This rejection is respectfully traversed.

Specifically, the Office Action states that Irribarren and Picard et al. discloses most of the claimed elements and Chau et al. discloses the rest of the claimed elements. The Applicants respectfully disagree for the reasons set forth below.

First, the Chau et al. reference does not recognize the problems solved by the presently claimed invention. Chau et al. sought to provide a solution that enabled a message service provider to make a subscriber's messages stored at a home mailbox at a home node available at a roaming mailbox at a roaming node<sup>23</sup>. Chau et al. does not recognize the need to integrate voice, fax and email messaging between disparate

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<sup>22</sup> USP 5,751,792.

<sup>23</sup> Chau et al. at col. 1 lines 35-38.



messaging interfaces which employ different messaging formats and which use different networks between subscribers *and non-subscribers* through a switchable communications backbone such as the Internet<sup>24</sup>. Therefore, the Applicants submit there would be no motivation to combine the teachings of Chau et al. with the teachings of Irribarren and Picard et al. For this reason, it cannot be said that Chau et al. in combination with Irribarren and Picard et al. make the presently claimed invention obvious.

#### Dependent Claims 101 and 102

Claims 101 and 102 depend from claim 100. As noted above, Irribarren and Picard et al. do not make claim 100 obvious. For the same reasons, Irribarren, Picard et al. and Chau et al. cannot be said to make claims 101 and 102 obvious.

#### Claim 103

Claim 103 includes limitations similar to those of claims 1 and 100. Accordingly, the previous remarks regarding claims 1 and 100 are equally applicable to claim 103. Therefore, the Applicants respectfully submit that claim 103 is similarly not rendered obvious under § 103 by Chau et al., either alone or in combination with Irribarren and Picard et al.

#### Claim 104

Claim 104 depends from claim 103. The argument set forth above with respect to claim 103 is equally applicable here. The base claim being allowable, the dependent claim must also be allowable.

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<sup>24</sup> Specification at p. 3 lines 8-11.

Claim 105

Claim 105 includes limitations similar to those of claims 1 and 100. Accordingly, the previous remarks regarding claims 1 and 100 are equally applicable to claim 105. Therefore, the Applicants respectfully submit that claim 105 is similarly not rendered obvious under § 103 by Chau et al., either alone or in combination with Irribarren and Picard et al.

Claims 106-110

Claims 106-110 depend from claim 105. The argument set forth above with respect to claim 105 is equally applicable here. The base claim being allowable, the dependent claims must also be allowable.

Claim 111

Claim 111 includes limitations similar to those of claims 1 and 100. Accordingly, the previous remarks regarding claims 1 and 100 are equally applicable to claim 111. Therefore, the Applicants respectfully submit that claim 111 is similarly not rendered obvious under § 103 by Chau et al., either alone or in combination with Irribarren and Picard et al.

Claim 112

Claim 112 depends from claim 111. The argument set forth above with respect to claim 111 is equally applicable here. The base claim being allowable, the dependent claim must also be allowable.

Claim 113

Claim 113 recites:

A method of delivering a message to a recipient serviced by a messaging apparatus defined within a multimedia messaging communications system, comprising:  
receiving a destination telephone number from a subscriber of the communications system;  
receiving a message intended for delivery to said destination telephone number;  
routing said message to a local telephone network if said destination telephone number includes a telephone prefix code which corresponds to said local telephone network;  
routing said message to a remote messaging apparatus which is coupled to a remote telephone network, if said destination telephone number includes a prefix code which corresponds to said remote telephone network; and  
delivering said message by using said remote messaging apparatus to establish a local call to a telephone interface which is defined within said remote telephone network.

Claim 113 includes limitations similar to those of claims 1 and 100. Accordingly, the previous remarks regarding claims 1 and 100 are equally applicable to claim 113. Therefore, the Applicants respectfully submit that claim 113 is similarly not rendered obvious under § 103 by Chau et al., either alone or in combination with Irribarren and Picard et al.

Additionally, according to the Office Action, Chau et al. discloses receiving said message intended for delivery to said destination telephone number<sup>25</sup>. The Office Action cites the following in support of this contention:

A subscriber can then obtain his/her messages from roaming node C.<sup>26</sup>

Thus, the cited reference discloses receiving a *delivered* message, not receiving a message *intended for delivery* to a destination telephone number. For this additional reason, it cannot be said that Iribarren in combination with Picard et al. and Chau et al. make the presently claimed invention obvious.

#### Claim 114

Claim 114 includes limitations similar to those of claims 1 and 100. Accordingly, the previous remarks regarding claims 1 and 100 are equally applicable to claim 114. Therefore, the Applicants respectfully submit that claim 114 is similarly not rendered obvious under § 103 by Chau et al., either alone or in combination with Iribarren and Picard et al.

In view of the foregoing, it is respectfully requested that the rejection of claims 101-114 be withdrawn.

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<sup>25</sup> Office Action ¶ 6, p. 9.

<sup>26</sup> Chau et al. at col. 4 lines 26-27.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "Version with markings to show changes made."

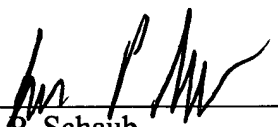
Request for Allowance

It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below. The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1698.

Respectfully submitted,  
Thelen Reid and Priest LLP

Dated: March 1, 2002

  
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**VERSION WITH MARKINGS TO SHOW CHANGES MADE****In the Claims**

Please add claims 115 and 116 as follows:

115. (NEW) A program storage device readable by a machine, embodying a program of instructions executable by the machine to perform a method to deliver a message to a recipient serviced by a messaging apparatus defined within a multimedia messaging communications system, the method comprising:
- receiving a destination telephone number from a subscriber of the communications system;
- receiving a message intended for delivery to said destination telephone number;
- routing said message to a local telephone network if said destination telephone number includes a telephone prefix code which corresponds to said local telephone network;
- routing said message to a remote messaging apparatus which is coupled to a remote telephone network, if said destination telephone number includes a prefix code which corresponds to said remote telephone network; and
- delivering said message by using said remote messaging apparatus to establish a local call to a telephone interface which is defined within said remote telephone network.

116. (NEW) An apparatus for delivering a message to a recipient serviced by a messaging apparatus defined within a multimedia messaging communications system, the apparatus comprising:
- means for receiving a destination telephone number from a subscriber of the communications system;
  - means for receiving a message intended for delivery to said destination telephone number;
  - means for routing said message to a local telephone network if said destination telephone number includes a telephone prefix code which corresponds to said local telephone network;
  - means for routing said message to a remote messaging apparatus which is coupled to a remote telephone network, if said destination telephone number includes a prefix code which corresponds to said remote telephone network; and
  - means for delivering said message by using said remote messaging apparatus to establish a local call to a telephone interface which is defined within said remote telephone network.